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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/680,041	Applicant(s) COCKERILLE ET AL.	
	Examiner Ponnoreay Pich	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/03, 10/05, 2/06, 2/07, 6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of group I (claims 1-11 and 16-26) in the reply filed on 5/4/2007 is acknowledged. Claims 1-11 and 16-26 were examined.

Information Disclosure Statement

The documents listed in the IDS's submitted have been considered. The documents crossed out in the IDS submitted on 6/29/07 were crossed out because the documents were already listed in a previously submitted IDS and as such do not need to be listed again.

Specification

The use of the trademarks LINUX, WINDOWS, REDHAT, QNX, and UNIX have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claim objected to because of the following informalities:

1. In line 9 of claim 1, instead of "which", the examiner believes "wherein the at least" should be recited.
2. In line 12 of claim 1, instead of "which" the examiner believes "wherein the one or more" should be recited.

3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 9, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 4 and 22 recite "the game of chance", which lacks antecedent basis. The examiner assumes applicant may have meant claims 4 and 22 to instead depend on claims 3 and 21 respectively instead of claims 1 and 19.
2. Claim 9 does not comply with 35 USC 112, second paragraph since a trademark cannot be used to identify a particular product in a claim, see MPEP 2173.05(u).
Unix, Windows, Linux, and QNX are all trademarks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 19 is directed towards an apparatus with comprising various means. According to applicant's specification, these means are implemented using a code authenticator and code comparator. On page 9, lines 12-14 of applicant's specification, applicant discloses that both the code authenticator and code comparator are software units. As such, it would appear that claim 19 is directed towards an apparatus comprising software per se, which is not statutory. Applicant can overcome this rejection by reciting some form of hardware as a component of the claimed apparatus.

Claims 20-26 are dependent on claim 19 and further define the claimed software apparatus of claim 19. These dependent claims also do not define any hardware for the claimed apparatus and as such are also not statutory because they are directed towards software per se.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 10, and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginsburg et al (US 6,595,856).

Claims 1 and 19:

As per claim 1, Ginsburg discloses:

- (a) Identifying a list of processes scheduled for execution on the gaming machine RAM (col 3, lines 53-56 and col 8, lines 10-15).
- (b) Selecting one process for verification from said list of processes (col 8, lines 16-17 and col 9, lines 2-6). *Note that one or more gaming processes are identified and selected to be verified by computing a live code for the selected process before the process is actually allowed to run.*
- (c) Identifying a file name and current RAM location of the selected process (col 8, lines 7-15 and col 8, line 65-col 9, line 6). *Note that to be able to compute a verification code for a specific process loaded into RAM, the current RAM location of the process must be identified. Further, to be able to compare the process in RAM to a program stored in mass storage, the file name of the process must be identified which corresponds to a program file stored in mass memory 270.*
- (d) At the current RAM location, inspecting said selected process to identify at least a first portion of the process, wherein the at least first portion of the process is a portion of the process that does not change during execution of the process (col 8, lines 7-15 and col 8, line 65-col 9, line 6). *The live codes and verification codes being compared are hash values. For a live code to correspond to a verification/authentication code of a file stored in mass memory, the portion of the RAM process used to compute the live code must be a portion that does not*

change since the files stored in mass memory 270 do not change. This means having to inspect the selected process to identify at least a first portion of the process that does not change during execution so that this portion could be hashed to generate a live code.

- (e) Identifying one or more gaming software programs stored on one or more file storage devices, wherein the one or more gaming software programs have the same name as the selected process (col 3, lines 53-56; col 8, lines 7-15; and col 8, line 65-col 9, line 6). *The process in RAM are loaded from the gaming software programs that are stored in mass memory storage device 270. As such, the software programs would have the same name as the processes loaded into RAM. Further, since an aspect of Ginsberg's invention allow for just specific files to be verified, this implies identifying one or more gaming software programs stored on mass memory storage device 270 to be used in the verification process.*
- (f) For each of the one or more identified gaming software programs, inspecting the gaming software programs to determine whether at least the first portion of the process is present (col 4, lines 16-19 and col 8, lines 16-27). *Comparing the verification codes to the live codes read on this limitation. If the codes match, this means that the first portion is present and the same for the files stored in RAM and mass memory.*

- (g) Generating a notification, i.e. alert, if none of the one or more gaming software programs contains the first portion of the selected process (col 4, lines 24-28 and col 8, lines 23-27).

Claim 19 is directed towards an apparatus comprising software means for implementing the method of claim 1 and is rejected for similar reasons as claim 1. Note that the method as recited in claim 1 is implemented via software in Ginsberg's invention.

Claims 3 and 21:

Ginsburg further discloses the step of and means for presenting a game of chance on the gaming machine (col 1, lines 59-62). Note that casino games are games of chance.

Claims 4 and 22:

Ginsburg further discloses wherein the game of chance is a video slot game, a mechanical slot game, a lottery game, a video poker game, a video black jack game, a video card game, a video bingo game, a video keno game, or a video pachinko game (Fig 3). Note that Figure 3 shows the gaming machine has a coin detector and a handle to play the game. Thus the gaming machine is a mechanical slot game.

Claims 5 and 23:

Ginsburg further discloses wherein the file storage devices are at least one of file storage devices located on the gaming machine, remote file storage devices or combinations thereof (col 3, lines 41-56). Note that Ginsburg discloses the file storage

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device could either be a mass memory storage device 270 or a CD-ROM media that is stored remotely and networked to the gaming machine.

Claims 6 and 24:

Ginsburg further discloses the step of and means for calling an attendant, i.e. operator, if none of the one or more gaming software programs contains the first portion of the selected process (col 4, lines 24-28).

Claim 10:

Ginsburg discloses:

- (a) Identifying the first gaming software as currently stored in the gaming device RAM (col 8, lines 10-15).
- (b) Identifying a second gaming software stored on a file storage device (col 3, lines 53-56; col 8, lines 7-15; and col 8, line 65-col 9, line 6).
- (c) Comparing at least a first portion of the second gaming software program with a first portion of the gaming software program as currently stored in the gaming device RAM (col 4, lines 16-19 and col 8, lines 16-27). *Ginsburg does this by comparing a live verification code with an authentication code. The live code is generated from gaming software identified as present in the gaming device's RAM. The authentication code is generated from a second gaming software stored in either mass storage device 270 or a CD-ROM.*
- (d) Wherein the first portion of the gaming software is a portion of the first gaming software program that does not change during execution of said first gaming software program (col 8, lines 7-15 and col 8, line 65-col 9, line 6). *The live*

codes and verification codes being compared are hash values. For a live code to correspond to a verification/authentication code of a file stored in mass memory, the portion of the RAM process used to compute the live code must be a portion that does not change since the files stored in mass memory 270 do not change.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsburg et al (US 6,595,856) in view of Alcorn et al (US 5,643,086).

Claims 2 and 20:

Ginsburg does not explicitly disclose wherein the gaming software programs are certified for executing on the gaming machine in one or more gaming jurisdictions by a regulatory entity within each of the gaming jurisdictions. However, the limitation is disclosed by Alcorn (col 8, lines 54-62). Note that in the cited passage of Alcorn, the gaming commission, i.e. regulatory entity, may require that a copy of the hash of the gaming software program also be stored with the gaming commission. In this manner, the gaming commission can audit the system thereby certifying the gaming software programs for execution on the gaming machine.

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At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Ginsburg's invention according to the limitations recited in claims 2 and 20 by using a regulatory entity within a gaming jurisdiction to certify gaming software programs for execution on the gaming machine. One skilled would have been motivated to do so for auditing purposes (Alcorn: col 8, lines 54-57). One skilled would also have been motivated to incorporate Ginsburg's teachings within the gambling machines disclosed by Alcorn because it would ensure game integrity at all times (Ginsburg: col 1, lines 52-56).

Claims 7-9, 11, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsburg et al (US 6,595,856).

Claims 7 and 25:

Ginsburg does not explicitly disclose the step of and means for shutting down the gaming machine if none of the one or more gaming software programs contains the first portion of the selected process. However, official notice is taken that shutting down a machine upon failure to authenticate was well known in the art at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to modify Ginsburg's invention such that it shuts down upon failure to authenticate the calculated codes, meaning that none of the one or more gaming software programs contains the first portion of the selected process. One skilled would have been motivated to do so because it would prevent usage of the gaming machine. Note this

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was something Ginsburg wanted to do upon failure to authenticate the codes (col 4, lines 22-25).

Claims 8 and 26:

Ginsburg does not explicitly disclose wherein the list of processes schedule for execution on the gaming machine RAM is specified by an operating system. However, official notice is taken that the limitation was well known in the art at the time applicant's invention was made. One skilled in the art of computing should understand that one of the tasks of an operating system is to schedule tasks to be executed in a machine's RAM, i.e. task scheduling and memory management. It would have been obvious to one skilled in the art to modify Ginsburg's invention according to the limitations recited in claims 8 and 26. One skilled would have been motivated to do because all computerized gaming systems contain an operating system and part of the task of an operating system is to schedule processes for execution in RAM and to manage memory.

Claim 9:

Ginsburg does not explicitly disclose wherein the gaming machine runs Unix, Windows, Linux, or QNX. However, official notice is taken that most gaming machines run some form of Unix, Windows, or Linux as the underlying operating system to control all other processes on the gaming machine. It would have been obvious to one skilled in the art to modify the gaming machine of Ginsburg to run Unix, Windows, or Linux. One skilled would have been motivated to do so because the gaming machine requires

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an operating system to run properly and Unix, Windows, or Linux is often used as the operating system of gaming machines.

Claim 11:

Ginsburg does not explicitly disclose wherein the gaming device is at least one of a player tracking unit, a player tracking server, a game server or a hand-held gaming device. However, official notice is taken that gaming devices being at least one of a player tracking unit, a player tracking server, a game server or a hand-held gaming device was well known in the art at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to utilize Ginsburg's invention in a gaming device that was either a player tracking unit, a player tracking server, a game server or a hand-held gaming device. One skilled would have been motivated to do so because incorporating Ginsburg's teachings within these gaming devices would ensure game integrity at all times (Ginsburg: col 1, lines 52-56).

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsburg et al (US 6,595,856) in view of Richardson (US 5,042,809).

Claims 16 and 17:

As per claim 16, Ginsburg discloses:

- (a) Identifying the first gaming software as currently stored in the gaming device RAM as specified by an operating system (col 8, lines 10-15). *Note that Ginsburg's device must have some form of operating system to control interaction between the hardware and software. In the cited portion, game software program that has been loaded into RAM is used to generate a live code. Since part of the function of an operating system is to manage memory, the first gaming software currently stored in the system's RAM is specified by an operating system.*
- (b) Identifying a second gaming software stored on a file storage device (col 3, lines 53-56; col 8, lines 7-15; and col 8, line 65-col 9, line 6).
- (c) Comparing at least a first portion of the second gaming software program with a first portion of the gaming software program as currently stored in the gaming device RAM (col 4, lines 16-19 and col 8, lines 16-27). *Ginsburg does this by comparing a live verification code with an authentication code. The live code is generated from gaming software identified as present in the gaming device's RAM. The authentication code is generated from a second gaming software stored in either mass storage device 270 or a CD-ROM.*
- (d) Wherein the first portion of the gaming software is a portion of the first gaming software program that does not change during execution of said first gaming software program (col 8, lines 7-15 and col 8, line 65-col 9, line 6). *The live codes and verification codes being compared are hash values. For a live code to correspond to a verification/authentication code of a file stored in mass memory,*

the portion of the RAM process used to compute the live code must be a portion that does not change since the files stored in mass memory 270 do not change.

Ginsburg does not explicitly disclose selecting the second gaming software program from a list of certified gaming software programs wherein the certified gaming software programs are stored on one or more file storage devices. However, the limitation is disclosed by Richardson (col 6, lines 43-45 and col 17, lines 32-50). Note that in the cited portions of Richardson, multiple licensed, i.e. certified, gaming software are available on a single gaming machine for a user to select to play.

At the time applicant's invention was made, it would have been obvious to one skilled in the art to incorporate Ginsburg's security teachings within the gambling machine disclosed by Richardson. One skilled would have been motivated to do so because Ginsburg's teachings would ensure game integrity at all times (Ginsburg: col 1, lines 52-56). Note that game security was a concern for Richardson (col 5, lines 16-22).

Claim 17 is directed towards a computer readable medium containing computer readable code to implement the method of claim 16 and is rejected for similar reasons given in claim 16.

Claim 18:

The method recited in claim 18 is substantially similar to the method recited in claim 16 and is rejected for much the same reasons. The difference is that claim 18 additionally recites "identifying an executable file name for the first gaming software program" and "wherein identifying the second gaming software program includes using

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the executable file name". Official notice is taken that both these limitations were well known in the art at the time applicant's invention was made. Specifically, processes executing in a Windows OS, for example, is identified not only by a process id, but also by their file name. One can verify this by viewing Window's task manager, which lists the processes loaded in RAM at any given time by process id and file name. Further, when one wants to find a specific file on a computer system, one usually does so by searching by file name.

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Ginsburg's invention such that the first gaming software was identified by file name and using that file name to find identify a second gaming software stored on a file storage system using the file name. One skilled would have been motivated to use the executable file name to identify the second gaming software because it is standard in the art of computing to search for a specific file by its file name.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 16-18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 20, and 50 respectively of prior U.S. Patent No. 6,685,567. This is a double patenting rejection.

Note that the only difference between claims 16-18 and claims 1, 20, and 50 of the '568 patent is that the claims of the current application specifies that the first gaming software program is stored in the gaming machine RAM *as specified by an operating system*. However, one skilled would appreciate that all computerized gaming devices that execute gaming software contain some form of operating system which specifies programs executing in the RAM of the computerized gaming device. Thus the extra limitation that the programs were specified by an operating system does nothing more than define what is already inherent to computerized gaming systems that execute gaming software. Claims 16-18 of the current application do not actually define an invention that is patentably distinct from what was already claimed in the '567 patent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rowe (US 2003/0028779) is cited of interest because though the assignee of the current application and Rowe's application is the same entity, the inventive entities are different. Further, Rowe's effective filing date precedes the current application's priority date by a few days. In reviewing the Rowe application, the examiner notes that Rowe's

disclosure may be applicable as a 102(e) reference for several of the claims of the current application. Applicant is respectfully advised to fully review Rowe and keep his teachings in mind when drafting any amendments in response to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

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